

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Linda I. Hoffberg-Borghesani, et al.  
Filed : February 2, 2000  
Serial No. : 09/497,071  
For : ADAPTIVE PATTERN RECOGNITION BASED CONTROL  
SYSTEM AND METHOD  
Group Art Unit: 2623  
Examiner : Salce, Jason P.

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January 3, 2012

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR REHEARING UNDER 37 § C.F.R. 41.52

Pursuant to 37 C.F.R. § 41.52, applicants herewith request rehearing.

## ARGUMENT

### ART REJECTIONS

#### CLAIMS 155-161, 174

The issues presented in Claim 155 are dispositive of the group.

Applicants have made at least the following substantive arguments in the Brief and Reply Brief which were not addressed by the Board in its decision dated October 31, 2011:

### **BRIEF**

The examiner states that the “automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user” step is met by Vogel at Col. 5, lines 13-20, which state as follows:

PROGRAM. Pressing this button causes a display such as that of FIG. 3 to be displayed. This display is known as the PROGRAM menu, and shows a list of scheduled programs for each available channel. Channel indicator box 301 shows the date and channel to which each column of schedule information relates. Each entry in the schedule shows the scheduled time of broadcast, title and censorship classification.

The examiner states that the available media are part of the real time data (Col. 3, lines 59-66). In this interpretation, the electronic program guide (EPG) data is not itself input by the user, and comprises the content characteristics of the available media. Since, according to this interpretation, the EPG is filtered based (merely) on the selected channel, a “search” is allegedly performed. It is respectfully submitted that, in fact, no search is performed by Vogel; the channel identifier of the selected channel is used as an index to reference a single listing in the EPG, and no “search” of the contents of the EPG is performed, as this term is commonly understood in the art by those of ordinary skill. Thus, for example, if a search were performed, then two available media with identical “data representing content characteristics” should both be returned. Note that the channel identifier is not a content characteristic of the media, but rather it represents delivery information. That is, a letter delivered to one street address does not have a different content characteristic than an identical letter delivered to a different address. Likewise, a letter delivered by FedEx to one address does not have a different content characteristic than an identical one delivered by the U.S. Postal service to the same address. The same media delivered on different channels, or to different destinations, maintains the same content. It is noted that the entries

made by the user for future recording are also not automatically searched for a correspondence, since the EPG entry itself is the basis for the selection.

The word "content" has accepted meanings in the art, and the examiner is not free to ignore the known and respected meaning. The examiner has misinterpreted this term to encompass the package or delivery mechanism for the media, rather than the media itself. Relevant definitions of the word "content" in Google (relating to media) are:

message: what a communication that is about something is about

subject: something (a person or object or scene) selected by an artist or photographer for graphic representation; "a moving picture of a train is more dramatic than a still picture of the same subject"

Meaning or message contained and communicated by a work of art, including its emotional, intellectual, symbolic, thematic, and narrative connotations.

[www.yannistavrou.gr/art-glossary.htm](http://www.yannistavrou.gr/art-glossary.htm)

The graphics, video, sound and text that makes up a web page is usually referred to as the content.

[www.verteo.com/support/files/glossary.cfm](http://www.verteo.com/support/files/glossary.cfm)

Message, idea, or feelings expressed in a work of art.

[www.kn.att.com/wired/art2/guide/glossary.html](http://www.kn.att.com/wired/art2/guide/glossary.html)

any files that are played back, including graphics files, sound files, video files, and script files themselves.

[www.digitalsignagetoday.com/glossary.php](http://www.digitalsignagetoday.com/glossary.php)

The message the work communicates. The content can relate to the subject matter or be an idea or emotion. Theme is another word for content.

[eclackhi.uclaek.k12.or.us/~edgintonw/Web/handouts/visualartvocab.doc](http://eclackhi.uclaek.k12.or.us/~edgintonw/Web/handouts/visualartvocab.doc)

information that is available online. The "message" rather than the "medium."

[cyber.law.harvard.edu/readinessguide/glossary.html](http://cyber.law.harvard.edu/readinessguide/glossary.html)

The expression, essential meaning, significance, or aesthetic value of a work of art. Content refers to the sensory, subjective, psychological, or emotional properties we feel in a work of art, as opposed to our perception of its descriptive aspects alone.

[www.khsd.k12.ca.us/bhs/Perry/art%20vocabulary.htm](http://www.khsd.k12.ca.us/bhs/Perry/art%20vocabulary.htm)

The intellectual substance of a document, including text, data, symbols, numerals, images, and sound. Along with context and structure, content is one of the three fundamental aspects of a record. [SAA: Glossary of Archival and Records Terminology]

[scinet33.un.org/unarms/en/unrecordsmgmt/unrecordsresources/glossaryofrecordlink.php.html](http://scinet33.un.org/unarms/en/unrecordsmgmt/unrecordsresources/glossaryofrecordlink.php.html)

the subject matter of a work of art and its values apart from the artist's ability.

Form and content are the two elements that comprise a work.

[www.worldimages.com/art\\_glossary.php](http://www.worldimages.com/art_glossary.php)

That which conveys information, eg text, data, symbols, numerals, images, sound and vision.

[www.noa.gov.au/recordkeeping/er/guidelines/14-glossary.html](http://www.noa.gov.au/recordkeeping/er/guidelines/14-glossary.html)

The "meat" of a document, as opposed to its format, or appearance.

[www.microsoft.com/technet/prodtechnol/Visio/yisvio2002/plan/glossary.mspx](http://www.microsoft.com/technet/prodtechnol/Visio/yisvio2002/plan/glossary.mspx)

Content refers to source data on which end-user searches are based. Content may consist of Web pages, FAQ items, glossary definitions, database records, or records from a Content Management System (CMS).

[publib.boulder.ibm.com/infocenter/discoverer/v8r4/topic/com.ibm.discovery.ds.mgmt.doc/c\\_MCG\\_Basic\\_Terms\\_and\\_Concepts.htm](http://publib.boulder.ibm.com/infocenter/discoverer/v8r4/topic/com.ibm.discovery.ds.mgmt.doc/c_MCG_Basic_Terms_and_Concepts.htm)

Information of interest to a human being - sound, text, pictures, video, etc. As opposed to computer software, which can be run on computers by people, but which is not useful and interesting information in and of itself.

[eladefense.com/ma-thesis/glossary.html](http://eladefense.com/ma-thesis/glossary.html)

The copy, words or actual content used within emails and websites.

[www.emaildirect.com/page.ww](http://www.emaildirect.com/page.ww)

the meaning communicated in a given work.

[www.creativephotography.org/education/guides/reframe/glossary.html](http://www.creativephotography.org/education/guides/reframe/glossary.html)

(It is noted that here, and hereinbelow, applicant has presented a body of linguistic information representing various definitions of claim terms. The Board is free to ignore these definitions, but must, as a part of its legal and factual obligation to properly interpret the claims, define the meaning of claim terms presented before considering the issue of prior art. See, Markman v. Westview Inst., 517 US 370 (1996). Therefore, in order to provide guidance for future prosecution, and fulfill its obligations of review, the Board is respectfully request to clearly enunciate its interpretation of the claims. KSR v. Teleflex, 550 U.S. \_\_\_, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), states: "To facilitate review, this analysis should be made explicit. See In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").)

## **REPLY BRIEF**

... Note that Vogel does not analyze the actual content of the media, and therefore do not provide any enabling disclosure of how such a distinction would be made.

The Examiner states that the program schedule data is received after a program selection by a user, and thus literally meets the claim language of "storing data describing available media and storing data representing previously selected media". However, given this same interpretation, Vogel does not meet the subsequent use of that data, "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media".

The Examiner argues that a manual search by a user through an automatically generated list presented on a screen is an "automatically" performed search. Applicant begs to differ; since the search itself remains manual, as no part of the automated system "searches" as required by the claims. See, Vogel, Col. 5, lines 13-20, cited by Examiner for the proposition that Vogel automatically performs a search. As previously stated, the "real time" information displayed according to Vogel, see Col. 3, lines 59-66, does not represent content.

characteristics of the previously selected media, and therefore the Examiner's analysis fails on both bases.

#### CLAIM 156

With respect to claim 156, the Examiner makes clear his interpretation of identifying information for television programs (shown in Fig. 4) as being content characteristics, which is believed erroneous per se, and also ignores that claim 155 requires that "said data representing content characteristics are not received as an input from a human user". Note that there is no enabling disclosure in Vogel, for a non-human input listing of program identifying information of the type provided. Therefore, the Examiner's rejection of claim 156 should be reversed.

Claim 155 provides:

155. A method for selecting media, comprising the steps of:  
storing data describing available media and storing data representing  
previously selected media;

automatically performing a search of said available media for a  
correspondence to data representing content characteristics of the previously  
selected media, wherein said data representing content characteristics are not  
received as an input from a human user; and

automatically issuing a notification of available media having  
characteristics corresponding to, but not identical to previously selected media,  
wherein said media comprises a media program.

With respect to the "search" issue, claim 155 provides: "automatically performing

a search of said available media for a correspondence to data representing content  
characteristics of the previously selected media, wherein said data representing  
content characteristics are not received as an input from a human user".

Vogel employs various electronic program guide data which are associated with programs, including channel, time, censorship classification, rating, title, description, etc. It is believed that the rating, title, and description would be understood by a person of ordinary skill in the art at the time of the invention, to be input from a human user, and are therefore expressly excluded from the scope of the claim. Even assuming arguendo that the channel and time information "are not received as an input from a human user",

(which is not admitted), this information does not represent “data representing *content characteristics* of the previously selected media”, since, for example, the time and channel are content agnostic, and in no way are characteristics. For example, “content characteristics” should transcend the mode of delivery of the media, or the data would not actually represent the “content characteristics”. On the other hand, time and channel are the epitome of mode of delivery, and clearly do not survive as “content characteristics” if the same content, which has the same “content characteristics” is rebroadcast at a different time or on a different channel. To find otherwise violates a basic understanding by persons of ordinary skill in the art of the meaning of both “content” and “characteristics”.

The word “content” (noun) means:

<http://dictionary.reference.com/browse/content>

1. Usually, contents.
  - a. something that is contained; the contents of a box.
  - b. the subjects or topics covered in a book or document.
  - c. the chapters or other formal divisions of a book or document: a table of contents.
2. something that is to be expressed through some medium, as speech, writing, or any of various arts: a poetic form adequate to a poetic content.
3. significance or profundity; meaning: a clever play that lacks content.
4. substantive information or creative material viewed in contrast to its actual or potential manner of presentation: publishers, record companies, and other content providers; a flashy Web site, but without much content.
5. that which may be perceived in something: the latent versus the manifest content of a dream.
6. Philosophy, Logic . the sum of the attributes or notions comprised in a given conception; the substance or matter of cognition.
7. power of containing; holding capacity: The bowl's content is three quarts.
8. volume, area, or extent; size.
9. the amount contained.
10. Linguistics . the system of meanings or semantic values specific to a language ( opposed to expression).
11. a. Mathematics . the greatest common divisor of all the coefficients of a given polynomial. Compare primitive polynomial.

b. any abstraction of the concept of length, area, or volume.

Origin:

1375–1425; late Middle English (< Anglo-French ) < Medieval Latin *contentum*, noun use of neuter of Latin *contentus* (past participle of *continēre* to contain), equivalent to con-+con- + ten- hold + -tus past participle suffix

Collins World English Dictionary

content 1 ('kɒntent)

1. (often plural) everything that is inside a container: the contents of a box

2. (usually plural)

a. the chapters or divisions of a book

b. a list, printed at the front of a book, of chapters or divisions together with the number of the first page of each

3. the meaning or significance of a poem, painting, or other work of art, as distinguished from its style or form

4. all that is contained or dealt with in a discussion, piece of writing, etc; substance

5. the capacity or size of a thing

6. the proportion of a substance contained in an alloy, mixture, etc: the lead content of petrol

[C15: from Latin *contentus* contained, from *continēre* to contain ]

Collins English Dictionary - Complete & Unabridged 10th Edition

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Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009

Etymonline

Word Origin & History

content

early 15c., from M.Fr. *contenter*, from *content* (adj.), c.1400, from L. *contentus* "contained, satisfied," pp. of *continere* (see contain). Sense evolved through "contained," "restrained," to "satisfied," as the contented person's desires are bound by what he or she already

has. Related: Contented (1520s); contentedly (1550s); contently (17c., superseded by contentedly).

Online Etymology Dictionary, © 2010 Douglas Harper

Merriam-Webster

Medical Dictionary

con-tent definition

Pronunciation: /'kän-,tent/

Function: n

1 : something contained —usually used in plural <the< span=""> stomach </the><content s>

2 : the subject matter or symbolic significance of something see LATENT CONTENT MANIFEST CONTENT

3 : the amount of specified material contained <the< span=""> sulfur  
</the><content of a sample>  
Merriam-Webster's Medical Dictionary, © 2007 Merriam-Webster, Inc.

American Heritage  
content con·tent (kōn'tēnt') n.  
Something contained, as in a receptacle.  
The proportion of a specified substance present in something else, as of protein in a food.  
The subject matter or essential meaning of something, especially a dream.  
The American Heritage® Stedman's Medical Dictionary  
Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by Houghton Mifflin Company.

The word “characteristic” (plural, characteristics) means:

<http://dictionary.reference.com/browse/characteristic>

characteristic  
adjective  
1. Also, char·ac·ter·is·ti·cal. pertaining to, constituting, or indicating the character or peculiar quality of a person or thing; typical; distinctive: Red and gold are the characteristic colors of autumn.  
noun  
2. a distinguishing feature or quality: Generosity is his chief characteristic.  
3. Mathematics .  
a. the integral part of a common logarithm. Compare mantissa.  
b. the exponent of 10 in a number expressed in scientific notation.  
c. the smallest positive integer  $n$  such that each element of a given ring added to itself  $n$  times results in 0.  
Origin: 1655–65; < Greek charaktēristikós. See character, -istic

Synonyms  
1. special, peculiar. 2. attribute, property, trait. See feature.  
Dictionary.com Unabridged Based on the Random House Dictionary, © Random House, Inc. 2011.

feature, device characteristic

Collins World English Dictionary  
characteristic (,kærɪkt̬rɪstɪk)  
— n  
1. a distinguishing quality, attribute, or trait  
2. maths  
a. Compare mantissa the integral part of a common logarithm, indicating the order of magnitude of the associated number: the characteristic of 2.4771 is 2  
b. another name for exponent, used esp in number representation in computing

— adj  
3. indicative of a distinctive quality, etc; typical  
Collins English Dictionary - Complete & Unabridged 10th Edition  
2009 © William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins  
Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009

Etymonline  
Word Origin & History  
characteristic both adj. and n. first attested 1660s, from character (q.v.) on model  
of Gk. *kharakteristikos*.  
Online Etymology Dictionary, © 2010 Douglas Harper

Merriam-Webster Medical Dictionary  
1 char·ac·ter·is·tic definition  
Pronunciation: /,kar-ik-tə- rɪs-tɪk/  
Function: adj  
: serving to reveal and distinguish the individual character  
char·ac·ter·is·ti·cal·ly Pronunciation: /-ti-k(ə-)lē/  
Function: adv  
2 characteristic definition  
Function: n  
: a distinguishing trait, quality, or property  
Merriam-Webster's Medical Dictionary, © 2007 Merriam-Webster, Inc.

American Heritage  
characteristic char·ac·ter·is·tic (kär'ək-tə-rɪs'tik)  
n. See character.  
char·ac·ter·is·tic adj.  
The American Heritage® Stedman's Medical Dictionary  
Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by  
Houghton Mifflin Company.

American Heritage Science Dictionary  
characteristic (kär'ək-tə-rɪs'tik) Pronunciation Key  
The part of a logarithm to the base 10 that is to the left of the decimal point. For  
example, if 2.749 is a logarithm, 2 is the characteristic. Compare mantissa.  
The American Heritage® Science Dictionary  
Copyright © 2002. Published by Houghton Mifflin. All rights reserved.

Thus, using any reasonable definition of “content characteristics”, or the  
composite words, the broadest reasonable interpretation of the claims in light of the  
interpretation by a person of ordinary skill in the art would not encompass characteristics

of the mode of communication of the media, but rather of the media itself delivered through the mode of communication.

In contrast, Vogel employs the word “classification”, which is distinct in meaning and application:

<http://dictionary.reference.com/browse/classification>

classification

[klas-uh-fi-key-shuhn]   Origin  
classification

noun

1. the act of classifying.
2. the result of classifying or being classified.
3. one of the groups or classes into which things may be or have been classified.
4. Biology . the assignment of organisms to groups within a system of categories distinguished by structure, origin, etc. The usual series of categories is phylum (or, especially in botany, division ), class, order, family, genus, species, and variety.
5. the category, as restricted, confidential, secret, or top secret, to which information, a document, etc., is assigned, as by a government or military agency, based on the degree of protection considered necessary to safeguard it from unauthorized use.

Origin:

1780–90; < Latin *classi* ( s ) class + -fication

Dictionary.com Unabridged

Based on the Random House Dictionary, © Random House, Inc. 2011.

Related Words for : classification: assortment, categorisation, categorization, compartmentalisation, compartmentalization

Collins World English Dictionary

classification ( .klæsifi'keʃən )

— n

1. systematic placement in categories
2. one of the divisions in a system of classifying
3. biology
  - a.the placing of animals and plants in a series of increasingly specialized groups because of similarities in structure, origin, molecular composition, etc., that indicate a common relationship. The major groups are domain or superkingdom, kingdom, phylum (in animals) or division (in plants), class, order, family, genus, and species
  - b.the study of the principles and practice of this process; taxonomy
4. government the designation of an item of information as being secret and not available to people outside a restricted group

[C18: from French; see class , -ify , -ation ]  
Collins English Dictionary - Complete & Unabridged 10th Edition  
2009 © William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins  
Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009

Etymonline  
Word Origin & History classification see classify.  
Online Etymology Dictionary, © 2010 Douglas Harper

Merriam-Webster Medical Dictionary  
clas·si·fi·ca·tion definition  
Pronunciation: /klas-(ə-)fɪ-kā-shən/  
Function: n  
1 : the act or process of classifying  
2 : systematic arrangement of animals and plants in groups or categories according to established criteria specifically : TAXONOMY 2  
Merriam-Webster's Medical Dictionary, © 2007 Merriam-Webster, Inc.

American Heritage  
classification clas·si·fi·ca·tion (klās'ə-fī-kā'shən)  
n.  
A systematic arrangement into classes or groups.  
The systematic grouping of organisms into categories on the basis of evolutionary or structural relationships between them; taxonomy.  
The American Heritage® Stedman's Medical Dictionary  
Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by Houghton Mifflin Company.

American Heritage Science Dictionary  
classification (klās'ə-fī-kā'shən) Pronunciation Key  
The systematic grouping of organisms according to the structural or evolutionary relationships among them. Organisms are normally classified by observed similarities in their body and cell structure or by evolutionary relationships based on the analysis of sequences of their DNA. See more at cladistics, Linnean. See Table at taxonomy.  
The American Heritage® Science Dictionary  
Copyright © 2002. Published by Houghton Mifflin. All rights reserved.

Merriam-Webster Legal Dictionary  
Main Entry: clas·si·fi·ca·tion  
Function: noun  
: the act or method of distributing into a class or category according to characteristics; also : a class or category determined by characteristics —see also SUSPECT CLASSIFICATION  
Merriam-Webster's Dictionary of Law, © 1996 Merriam-Webster, Inc.

Therefore, it is respectfully submitted that no teaching or suggestion of Vogel properly corresponds to this aspect, and therefore the reference fails to establish a *prima facie* case of anticipation.

Applicants did not argue per se that “Vogel does not describe a search that returns ‘two available media with identical’ data representing content characteristics.” Rather, applicants argued that *if* two available media were had identical data representing content characteristics of the previously selected media, then according to claim 155, the search would yield both having the same correspondence. This is distinct from Vogel, which, since it does not search for “a correspondence to data representing content characteristics of the previously selected media”, would not provide the same correspondence for both available media. Thus, applicants have argued,

The examiner states that the available media are part of the real time data (Col. 3, lines 59-66). In this interpretation, the electronic program guide (EPG) data is not itself input by the user, and comprises the content characteristics of the available media. Since, according to this interpretation, the EPG is filtered based (merely) on the selected channel, a “search” is allegedly performed. It is respectfully submitted that, in fact, no search is performed by Vogel; the channel identifier of the selected channel is used as an index to reference a single listing in the EPG, and no “search” of the contents of the EPG is performed, as this term is commonly understood in the art by those of ordinary skill. Thus, for example, if a search were performed, then two available media with identical “data representing content characteristics” should both be returned. Note that the channel identifier is not a content characteristic of the media, but rather it represents delivery information. That is, letter delivered to one street address does not have a different content characteristic than an identical letter delivered to a different address. Likewise, a letter delivered by FedEx to one address does not have a different content characteristic than an identical one delivered by the U.S. Postal service to the same address. The same media delivered on different channels, or to different destinations, maintains the same content. It is noted that the entries made by the user for future recording are also not automatically searched for a correspondence, since the EPG entry itself is the basis for the selection.

In order for Vogel to anticipate claim 155, it must necessarily encompass the claimed subject matter, and not merely possibly result in a similar output for selected cases, i.e., a trivialization of the claim. Inherency may not be established by mere probabilities or possibilities regarding what may have resulted in the prior art. *In re Oelrich*, 666 F.2d 578, 212 USPQ 323, 326 (Fed. Cir. 1981). The results, given the known factors influencing the results, must be predictable and assured, and where the reference fails to fully recite the claimed invention, must provide specific guidance to the person or ordinary skill in the art to modify the teachings to practice applicants' invention as claimed. The accidental attainment of a claimed invention, without recognition of the result or how it was achieved, is not anticipatory. *Tilghman v. Proctor*, 102 U.S. 707, 26 L.Ed. 279 (1880). The Supreme Court considered it "absurd" to find anticipation where the prior art process for purifying fats and oils preparatory to soap-making had produced fat acids in accordance with the process of the claim at issue because the acids were accidentally and unwittingly produced, without knowledge of what was done or how it was done. In *Eibel Process Co. v. Minnesota & Ont. Paper Co.*, 261 U.S. 45 (1923), the Court held that a method for increasing production speed of a paper-making machine by tilting the wire cloth sieve 12 inches was patentably distinguishable over a prior art paper-making machine that tilted the sieve 3 inches in two ways: (1) the wire was tilted for a different purpose; and (2) the degree of pitch was much greater. The Court further held that any increase in speed achieved in the prior art machine was accidental, unintentional and unappreciated, and therefore did not anticipate Eibel.

In a method claim, the defined end result recited is a relevant factor and material element of the claim. Even if a claimed method comprises intermediate steps identical to

those of a method practiced in the prior art, and the same result *would* have been achieved in the prior art method if the remaining steps were carried out, the accidental or unwitting achievement of that result cannot constitute anticipation. *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

It is therefore believed that the rejection of claims 155-161 and 174 under 35 U.S.C. § 102(e) in view of Vogel should be reversed.

Respectfully submitted,



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